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EXAMINER

BONSHOCK, DENNIS G

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 07/26/2004

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/919,764

Applicant(s)

GRAINGER, JEFFRY J.

Examiner

Dennis G Bonshock

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9 and 10.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 2 is objected to because of the following informalities: the claim states a "compute-readable medium" which is grammatically incorrect. Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8, 13, 20, 21, and 27-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Office, *Annual Technical Report*, hereinafter WIPO and Bambridge, *A Java Application Framework for Support Staff and epoline (MADRAS)*, hereinafter MADRAS.

4. With regard to claim 1, which teaches a user interface that provides access to patent information comprising: a first display section that displays a plurality of first file links selectable by the user, each of the links providing access to a patent document, and stored on a computer readable medium in an image file format, further teaching a second display section which displays a plurality of second file links selectable by the user, providing access to a patent file and stored on a computer readable medium, further teaching the patent documents and the patent files accessible from the first and second display sections all pertains to the patent application, WIPO teaches a system

referred to as PHOENIX which was developed to completely remove all paper files and replace them with electronic versions, containing all data normally found in the paper folders, WIPO teaches the system managing incoming files (similar to the first display section of the applicant), on page 32, item 5, paragraph 1, and being able to view the specific document, on page 32, item 5, paragraph 1, he further teaches that these item are related to the items in a paper folder, ie related to the case, on page 32, item 5, paragraph 1. MADRAS further describes the environment in which PHOENIX is used in, when they teach MADRAS being used as a user interface used for accessing the PHOENIX database (see page 2). It would have been obvious to one of ordinary skill in the art, having the teachings of WIPO and MADRAS before him at the time the invention was made to modify the system of obtaining electronic versions of patent documents of WIPO to include the MADRAS interface as did MADRAS. One would have been motivated to make such a combination because MADRAS provides an intuitive interface to the PHOENIX database and is know to be the primary means of accessing data in a PHOENIX.

5. With regard to claims 2 and 21, which teach the patent files on a computer readable medium in a format native to the application program or convertible to the native application program, WIPO teaches, on page 32, viewing the image file system on remotes client systems capable of viewing the computer data.

6. With regard to claim 3, which teaches at least one of the patent files accessible through the plurality of second file links corresponding to a patent document accessible through the first file links, WIPO teaches, on page 32, that accessing the incoming

documents provides access to the individual files that are normally found in a file wrapper.

7. With regard to claim 4, which teaches a third display section containing a correspondence between one or more of: inventor, in-house, or outside representative client systems, pertaining to the patent, WIPO teaches, on page 32, item 5, paragraph 1, the user having access to messages and the ability to issue letters (a communication means between the applicant and the patent office).

8. With regard to claims 5 and 29, which teach the first, second, and third plurality of file links being either html links or folders, WIPO teaches on pages 32-33, the user accessing either the group of documents (a folder, as in a specific mailing), or the link to that actual document over the web.

9. With regard to claim 6, which teaches the first, second, and third sections being a panel on a Web page, WIPO teaches on pages 32-33, the user accessing either the group of documents (a folder, as in a specific mailing), or the link to that actual document over the web. MADRAS teaches, as cited above the use of panels in an interface environment.

10. With regard to claim 7, which teaches the sections on a Windows based environment, MADRAS further teaches, on page 2, the first, second, and third sections being panels in a Windows environment.

11. With regard to claims 8 and 27, which teach the sections displayed adjacent to each other across a width of a display, on page 2, the first, second, and third sections being panels being displayed adjacent to one another across the width of the interface.

12. With regard to claim 13, WIPO teaches a system referred to as PHOENIX which was developed to completely remove all paper files and replace them with electronic versions, containing all data normally found in the paper folders, WIPO teaches the system managing incoming files (similar to the first display section of the applicant), on page 32, item 5, paragraph 1, and being able to view the specific document, on page 32, item 5, paragraph 1, he further teaches that these item are related to the items in a paper folder, ie related to the case, on page 32, item 5, paragraph 1. WIPO further teaches, on page 32, item 5, paragraph 1, the user having access to messages and the ability to issue letters (a communication means between the applicant and the patent office). MADRAS further describes the environment in which PHOENIX is used in, when they teach MADRAS being used as a user interface used for accessing the PHOENIX database (see page 2). It would have been obvious to one of ordinary skill in the art, having the teachings of WIPO and MADRAS before him at the time the invention was made to modify the system of obtaining electronic versions of patent documents of WIPO to include the MADRAS interface as did MADRAS. One would have been motivated to make such a combination because MADRAS provides an intuitive interface to the PHOENIX database and is know to be the primary means of accessing data in a PHOENIX.

13. With regard to claim 20, WIPO teaches a system referred to as PHOENIX which was developed to completely remove all paper files and replace them with electronic versions, containing all data normally found in the paper folders, WIPO teaches the

system managing incoming files (similar to the first display section of the applicant), on page 32, item 5, paragraph 1, and being able to view the specific document, on page 32, item 5, paragraph 1, he further teaches that these item are related to the items in a paper folder, ie related to the case, on page 32, item 5, paragraph 1. WIPO further teaches, on page 32, item 5, paragraph 1, the user having access to messages and the ability to issue letters (a communication means between the applicant and the patent office) and the viewing being on a remote client computer (see page 32, item 5, paragraph 2). MADRAS further describes the environment in which PHOENIX is used in, when they teach MADRAS being used as a user interface used for accessing the PHOENIX database (see page 2). It would have been obvious to one of ordinary skill in the art, having the teachings of WIPO and MADRAS before him at the time the invention was made to modify the system of obtaining electronic versions of patent documents of WIPO to include the MADRAS interface as did MADRAS. One would have been motivated to make such a combination because MADRAS provides an intuitive interface to the PHOENIX database and is know to be the primary means of accessing data in a PHOENIX.

14. With regard to claim 28, which teaches the first and third sections comprising a create icon that when selected by a client system creates a document to be stored in that section, wherein at least some information in the document is populated with information stored in the database, WIPO teaches, on page 32, the correspondence that takes place, and on page 33, the ability to file online, both imply that there need me

some means of starting the document, this information, after created, then becomes part of the PHOENIX database.

15. With regard to claim 30, which teaches the first and third sections comprising a upload icon that when selected allows an electronic document to be associated with the patent application, WIPO teaches, on page 33, the ability to do online filing where it would be obvious that the client would upload documents to the server, requiring some sort of icon.

16. With regard to claim 31, which teaches at least one of the patent files corresponds to one of the patent documents, WIPO teaches, on page 32, the individual patent files being a part of the patent documents sent in.

17. With regard to claim 32, WIPO teaches a system referred to as PHOENIX which was developed to completely remove all paper files and replace them with electronic versions, containing all data normally found in the paper folders, WIPO teaches, on page 32 a user accessing the electronic document, where the user's workstation would obviously contain a processor, a database, and a memory for storing the computer program, WIPO further teaches the system managing incoming files (similar to the first display section of the applicant), on page 32, item 5, paragraph 1, and being able to view the specific document, on page 32, item 5, paragraph 1, he further teaches that these items are related to the items in a paper folder, i.e. related to the case, on page 32, item 5, paragraph 1. WIPO further teaches, on page 32, item 5, paragraph 1, the user having access to messages and the ability to issue letters (a communication means between the applicant and the patent office). MADRAS further describes the

environment in which PHOENIX is used in, when they teach MADRAS being used as a user interface used for accessing the PHOENIX database (see page 2). It would have been obvious to one of ordinary skill in the art, having the teachings of WIPO and MADRAS before him at the time the invention was made to modify the system of obtaining electronic versions of patent documents of WIPO to include the MADRAS interface as did MADRAS. One would have been motivated to make such a combination because MADRAS provides an intuitive interface to the PHOENIX database and is known to be the primary means of accessing data in a PHOENIX.

18. With regard to claim 33, WIPO teaches a system referred to as PHOENIX which was developed to completely remove all paper files and replace them with electronic versions, containing all data normally found in the paper folders, WIPO teaches, on page 32, item 5, paragraph 2, a users accessing the information from anywhere. WIPO further teaches the system managing incoming files (similar to the first display section of the applicant), on page 32, item 5, paragraph 1, and being able to view the specific document, on page 32, item 5, paragraph 1, he further teaches that these item are related to the items in a paper folder, ie related to the case, on page 32, item 5, paragraph 1. WIPO further teaches, on page 32, item 5, paragraph 1, the user having access to messages and the ability to issue letters (a communication means between the applicant and the patent office). MADRAS further describes the environment in which PHOENIX is used in, when they teach MADRAS being used as a user interface used for accessing the PHOENIX database (see page 2). MADRAS further teaches, on page 2, the PHOENIX database communicating through a server with the MADRAS

User Interface, It would have been obvious to one of ordinary skill in the art, having the teachings of WIPO and MADRAS before him at the time the invention was made to modify the system of obtaining electronic versions of patent documents of WIPO to include the MADRAS interface as did MADRAS. One would have been motivated to make such a combination because MADRAS provides an intuitive interface to the PHOENIX database and is known to be the primary means of accessing data in a PHOENIX.

19. With regard to claim 34, which teaches the communication network being the Internet, WIPO further teaches on page 33, the user having the ability to file online.

20. Claims 9-12, 14, 17-19, 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over WIPO, MADRAS, and USPTO, EAST, hereinafter EAST.

21. With regard to claim 9, which teaches the second display section including a plurality of fourth file links, being prior art references, WIPO and MADRAS teach the system for displaying patent documents in an electronic form as noted above, but don't specifically show a plurality of fourth file links, being prior art references, EAST teaches a system for viewing patent related documents in a plurality of windows, similar to that of WIPO and MADRAS, but further teaches, in figure EAST 1, the HTML tab providing links to Related Patents. It would have been obvious to one of ordinary skill in the art, having the teachings of WIPO, MADRAS, and EAST before him at the time the invention was made to modify the interfaces of WIPO and MADRAS to include these prior art links in the document. One would have been motivated to make such a combination because the prior art references are going to be in the document of WIPO

and MADRAS anyway, because they are said to contain all the files normally in the file wrapper, where the IDS contains these references.

22. With regard to claim 10, which teaches the first and second display sections being separate windows, WIPO and MADRAS teach the system for displaying patent documents in an electronic form as noted above, but don't specifically show the first and second display sections being separate windows, EAST teaches a system for viewing patent related documents in a plurality of windows, similar to that of WIPO and MADRAS, but further teaches, in figure EAST 1, the display of the first and second sections in separate windows. It would have been obvious to one of ordinary skill in the art, having the teachings of WIPO, MADRAS, and EAST before him at the time the invention was made to modify the interfaces of WIPO and MADRAS to include the ability to display the first and second screens in the same window or in different windows. One would have been motivated to make such a combination to allow for moving sections about the display.

23. With regard to claim 11, which teaches the first and second display sections being panels of a single window, WIPO and MADRAS teach the system for displaying patent documents in an electronic form as noted above, but don't specifically show the first and second display sections being separate windows, EAST teaches a system for viewing patent related documents in a plurality of windows, similar to that of WIPO and MADRAS, but further teaches, in figure EAST 2, the display of the first and second sections in a the same window. It would have been obvious to one of ordinary skill in the art, having the teachings of WIPO, MADRAS, and EAST before him at the time the

invention was made to modify the interfaces of WIPO and MADRAS to include the ability to display the first and second screens in the same window or in different windows. One would have been motivated to make such a combination to allow for moving sections about the display.

24. With regard to claims 12, 19, and 22, which teach the patent documents being locked and not available to be edited, WIPO and MADRAS teach the system for displaying patent documents in an electronic form as noted above, but don't specifically show the patent documents being locked and not available to be edited, EAST teaches, a system for viewing patent related documents in a plurality of windows, similar to that of WIPO and MADRAS, but further teaches, in figure EAST 1 and 3, the documents being unable to be edited (Image, Text, HTML). It would have been obvious to one of ordinary skill in the art, having the teachings of WIPO, MADRAS, and EAST before him at the time the invention was made to modify the interfaces of WIPO and MADRAS to include the ability to provide uneditable documents. One would have been motivated to make such a combination because after documents are submitted and are being considered the applicant will not be able to change their work.

25. With regard to claim 14, which further teaches the patent files on a computer readable medium in a format native to the application program or convertible to the native application program, WIPO teaches, on page 32, viewing the image file system on remotes client systems capable of viewing the computer data.

26. With regard to claim 17, which teaches the first, second, and third display sections comprising a plurality of rows containing a file link selectable by a user to allow

the user to view one or more of the correspondence, WIPO and MADRAS teach the system for displaying patent documents in an electronic form as noted above, but don't specifically show the first, second, and third display sections comprising a plurality of rows containing a file link selectable by a user to allow the user to view one or more of the correspondence, EAST teaches, a system for viewing patent related documents in a plurality of windows, similar to that of WIPO and MADRAS, but further teaches in figures EAST 1-3, the systems containing rows of selectable file link information. It would have been obvious to one of ordinary skill in the art, having the teachings of WIPO, MADRAS, and EAST before him at the time the invention was made to modify the interfaces of WIPO and MADRAS to include the ability to provide the selectable rows of file links as did EAST. One would have been motivated to make such a combination because this would provide an easy way to access any of a plurality of documents.

27. With regard to claim 18, which teaches the first, second, and third plurality of file links being either html links or folders, WIPO further teaches on pages 32-33, the user accessing either the group of documents (a folder, as in a specific mailing), or the link to that actual document over the web.

28. With regard to claim 23, which teaches the patent document being in a bit mapped format, WIPO and MADRAS teach the system for displaying patent documents in an electronic form as noted above, but don't specifically show the patent document being in a bit mapped format, EAST teaches, a system for viewing patent related documents in a plurality of windows, similar to that of WIPO and MADRAS, but further teaches in figure EAST 1 and 3, the documents being unable (bit mapped) to be edited

(Image, Text, HTML). It would have been obvious to one of ordinary skill in the art, having the teachings of WIPO, MADRAS, and EAST before him at the time the invention was made to modify the interfaces of WIPO and MADRAS to include the bit mapped documents as did EAST. One would have been motivated to make such a combination because this is likely the form a scanned document will take.

29. With regard to claim 24, which teaches the patent documents stored in a bit mapped format include documents scanned from a paper document and documents generated from patent files, in figure EAST 1 and 3, the documents being unable (bit mapped) to be edited. Where the image file is a scanned in representation of the patent and the Text file is a document generated from the patent files.

30. Claims 15, 16, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over WIPO, MADRAS, and USPTO, WEST, hereinafter WEST.

31. With regard to claim 15, which teaches a forth section including summary information related to the patent application, including at least title and file number, WIPO and MADRAS teach the system for displaying patent documents in an electronic form as noted above, but don't specifically show a forth section including summary information related to the patent application, including at least title and file number, WEST teaches, a system for viewing patent related documents in a plurality of windows, similar to that of WIPO and MADRAS, but further teaches in figure WEST 1, that the left hand column containing summary information. It would have been obvious to one of ordinary skill in the art, having the teachings of WIPO, MADRAS, and WEST before him at the time the invention was made to modify the interfaces of WIPO and MADRAS to

include the forth section containing summary information. One would have been motivated to make such a combination because this would provide a means for the user to get a quick idea of what the particular documents is about.

32. With regard to claim 16, which teaches the fourth section comprises an icon that when selected provides additional information, in figure WEST 1, that the left hand column contains summary information where upon double clicking provides a more detailed description in the right hand column.

33. With regard to claim 25, which teaches the web page including an information icon that causes an information web page to be displayed, with at least the filing date and application number, WIPO and MADRAS teach the system for displaying patent documents in an electronic form as noted above, but don't specifically show the web page including an information icon that causes an information web page to be displayed with at least the filing date and application number, WEST teaches, a system for viewing patent related documents in a plurality of windows, similar to that of WIPO and MADRAS, but further teaches in figure WEST 1, that the left hand column contains summary information where upon double clicking provides a more detailed description in the right hand column. It would have been obvious to one of ordinary skill in the art, having the teachings of WIPO, MADRAS, and WEST before him at the time the invention was made to modify the interfaces of WIPO and MADRAS to include the selectable summary information. One would have been motivated to make such a combination because this would provide a means for the user to get a quick idea of what the particular documents is about before opening it.

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34. With regard to claim 26, which teaches the information web page including links to additional information, including priority information, power of attorney information, assignment information and comments, WIPO further teaches, on page 32, all of the document normally found in the paper folder being included, where the priority information, power of attorney, and assignment information are usually included in the folder.

Conclusion

35. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach systems for electronically displaying information related to a patent.

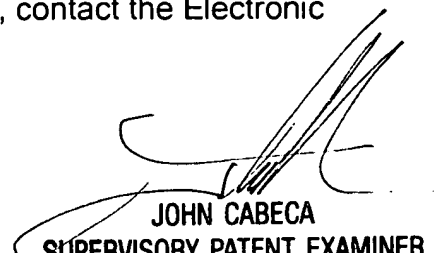
36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis G Bonshock whose telephone number is (703) 305-4668. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

37. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (703) 308-3116. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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38. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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